

REMARKS

Claims 1–4, 7–10, 13, 14, 26–32, 44–47 are currently pending in the subject application and are presently under consideration. Claims 1, 3 13, 14, 26, and 44 have been amended as shown on pages 2–7 of the Reply. Claims 35–43 have been cancelled herein.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Provisional Double Patenting Rejection of Pending Claims

The pending claims are provisionally rejected under the judicially created doctrine of obviousness–type double patenting as being unpatentable over claims 1–46 of the co–pending Application 10/997,450. The rejection is traversed because the Office has not met the requirements for a double patenting rejection. According to MPEP 804(II)(B)(1):

Since the analysis employed in an obviousness–type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, ..., that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious–type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim ** relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness–type double patenting is made in light of these factual determinations.

Any obviousness–type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude

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Filed: 03/08/2000

that the invention defined in the claim **>at issue would have been< an obvious variation of the invention defined in a claim in the patent..

See also MPEP(III): "...a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent".

Applicant requests either withdrawal of the rejection or presentation of a prima facie case that supports the rejection.

The provisional rejection is further traversed because the invention of the claims of Application 10/997,450 are patentably distinct from the present claims. As discussed below, the present claims recite various features not found in the claims of Application 10/997,450. For example, claim 1 recites determining at the device driver both whether the printer is configured to decompress the type of compression and determining whether the device driver is capable of decompressing the type of compression. None of the claims in Application 10/997,450 recite this feature.

In view of the patentable distinctions between the claims of the present application and the claims of Application 10/997,450, withdrawal of the rejection is respectfully requested.

II. Rejection of Claims 13 and 14 Under 35 U.S.C. §101

Claims 13 and 14 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. These claims are amended to recite *tangible* which precludes coverage of signals. Withdrawal of this rejection is respectfully requested.

III. Rejection of the Claims Under 35 U.S.C. §103(a)

Claims 1-4, 7, 8, 10, 13, 14, and 26-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ikegawa (US Patent 6,538,758) in view of Cosman (US Patent 6,707,948). Claims 9, 32 and 44-47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over

Ikegawa (US Patent 6,538,758) in view of Cosman (US Patent 6,707,948) in further view of Applicant's admitted prior art.

Withdrawal of this rejection is requested for at least the following reasons.

Independent claim 1 recites determining at a device driver both whether the printer is configured to decompress the type of compression and determining whether the device driver is capable of decompressing the type of compression.

Ikegawa is cited as teaching determining whether a printer supports compression. However, claim 1 involves determining more generally whether an application can send a file compressed with a type of compression to a device via its device driver; an application can query whether the compression is supported and that support can come from either the driver or the printer. Cosman only discusses details of compression and has no bearing on determining whether to send a compressed file to a printer based on both whether the printer supports the compression of the file and whether the device driver supports the compression of the file.

Claim 13 recites a device support query component that determines whether a printer is configured to perform a type of decompression corresponding to a type of compression of a compressed data file associated with an application and also determines whether a device driver for the printer is configured to perform the type of decompression.

Claim 26 recites receiving a response whether the printer is configured to decompress a file, the response having been made based both on whether the printer supports a type of compression by which the data file was compressed and based on whether a device driver for the printer supports the type of compression.

Claim 44 recites responding to a request from an application by determining whether the printer is configured to perform decompression for the type of compression of the compressed data file and determining whether a device driver for the printer is configured to perform decompression for the type of compression.

In view of at least the foregoing, it is readily apparent that Ikegawa and Cosman fail to teach or suggest all aspects of the claimed invention. Accordingly, it is respectfully requested that this rejection of independent claims 1, 13, 26, and 35 (and the claims that depend there from) should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-0463.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution the Examiner is invited to contact Applicant's undersigned representative at the telephone number below.

Respectfully submitted,

Microsoft Corporation

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April 19, 2007
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Microsoft Corporation
Application No.: 09/520,435
Filed: 03/08/2000